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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,062	05/14/2001	Michael A. Bass	32759US1	8583
116	7590	02/05/2004	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 02/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N .	Applicant(s)	
	09/855,062	BASS, MICHAEL A.	
	Examiner Yogesh C Garg	Art Unit 3625	
<b>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</b>			
<b>Period for Reply</b>			
<b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</b>			
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>			
<b>Status</b>			
<p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>29 October 2003</u>.</p> <p>2a)<input checked="" type="checkbox"/> This action is <b>FINAL</b>.      2b)<input type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>			
<b>Disposition of Claims</b>			
<p>4)<input checked="" type="checkbox"/> Claim(s) <u>1-5,7-15,22,23,26-35 and 37-40</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) _____ is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>1-5,7-15,22,23,26-35 and 37-40</u> is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8)<input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p>			
<b>Application Papers</b>			
<p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on _____ is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner.</p> <p style="margin-left: 20px;">Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p style="margin-left: 20px;">Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).</p> <p>11)<input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.</p>			
<b>Priority under 35 U.S.C. §§ 119 and 120</b>			
<p>12)<input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input type="checkbox"/> All    b)<input type="checkbox"/> Some *    c)<input type="checkbox"/> None of:</p> <p style="margin-left: 20px;">1.<input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p style="margin-left: 20px;">2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p style="margin-left: 20px;">3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p> <p style="margin-left: 20px;">* See the attached detailed Office action for a list of the certified copies not received.</p> <p>13)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.</p> <p>a)<input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>14)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.</p>			
<b>Attachment(s)</b>			
<p>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.</p>		<p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____.</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____.</p>	

## DETAILED ACTION

### ***Response to Amendment***

1. Amendment D, paper # 16 and supplemental Amendments E, paper # 17 & received on October 22<sup>d</sup> and 29, 2003, respectively are acknowledged and entered. Claims 6, 16-21, 24-25, 36 are cancelled. Claims 1, and 38 are currently amended. Currently claims 1-5, 7-15, and 22-23, 26-35, and 37-40 are pending for examination.

### ***Response to Arguments***

2. The amended preambles of claims 1 and 38 now include the newly added limitation, "consisting essentially of the following steps in the following order " and based upon this newly added limitation the applicant has argued that these claims are allowable (see amendment E, page 7). Also in a personal interview with the office on October 14, 2003 it was indicated to the applicant the claims appear allowable (see Interview summary, paper # 15). The applicant's arguments have been considered fully and diligently but they are not persuasive for following reasons:

(i) See MPEP 2111.03, " ....A consisting essentially of claim occupies a middle ground between closed claims that are written in a consisting of format and fully open claims that are drafted in a comprising' format." *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). See also *Atlas Powder v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ893 (CCPA 1963); *Water Technologies Corp. vs. Calco, Ltd.*, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." ..... applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989) ("Although consisting essentially of is typically used and defined in the context of compositions of matter, we find nothing intrinsically wrong with the use of

*such language as a modifier of method steps. . . [rendering] the claim open only for the inclusion of steps which do not materially affect the basic and novel characteristics of the claimed method. To determine the steps included versus excluded the claim must be read in light of the specification. . . "*

*As per MPEP 2111.03, the transition phrase, "consisting essentially of" will be construed as equivalent to the open-ended term "comprising" until and unless the specification explicitly points out the exclusion of any element/step or ingredients. In the instant application, the disclosure does not explicitly disclose the recited limitation, "consisting essentially of the following steps in the following order" , i.e., any change in the order of steps as recited in claims 1 and 38 is strictly excluded because the different order of steps would materially change the characteristics of the claimed invention.*

Also, for the similar reasons as given and analyzed above, the limitation "the following steps in the following order" is not supported by the disclosure.

In view of the above, the limitation, "consisting essentially of the following steps in the following order" , in claims 1-5, 7-15, and 22-23, 26-35, and 37-40 , would be further treated on merits as "comprising".

(ii) Overview: Both independent method (process) claims 1 and 38 appear to be very broad in nature. The recited steps comprise (1) providing a sign-it is very old and well-known practice that signs are provided to be used for selling goods/services or provide advertisement/information about products and services (2) purchasing a sign from a retail store-it is old and well-known that signs for selling products/services are available in retail stores (3) providing a website- it is old and well-known to provide a site to merchants/sellers (4) the seller placing the sign with an ID on the good or adjacent to the good-it is old and well-known to place signs on cars/properties (5) seller obtaining an ID and logging on a website using the ID to input information on the website. Further activities like purchaser viewing posted information about

said good on websites, using preprinted instructions to carry out an activity like installing, playing, copying, posting information, etc. are old and well known. Subscribers do need a website address and an ID to access a website and do input information on a website for the use/information of others.

(iii) The limitations as indicated above are met by FSBO except that it does not disclose buying the signs from a retail store and then the seller accesses the web site. As analyzed in the earlier Office action, Berlin teaches explicitly that it is old and well-known to buy products, on Internet as well as from the physical stores, especially for those customers who do not feel comfortable in buying goods online (see at least col.1, line 7-col.4, line 14). In view of Berlin, it would be obvious to a person of an ordinary skill in the art at the time of the invention to combine the teachings of Berlin with that of FSBO for those customers who do feel comfortable in buying goods on Internet to modify FSBO to provide signs to be purchased conventionally from stores instead via electronic methods as explicitly taught in Berlin (see at least col.3, line 60-col.4, line 14). Regarding motivation to combine references. The examiner would also like to bring to the applicant's attention that his arguments, " From claim 1, it is now clear.....by first purchasing the "for sale " sign .....After having purchased .....he wishes to sell " (see remarks, page 3, lines 19-22) are not consistent with the language of the claim 1. Claim 1 does not recite the limitation of "first purchasing the "for sale " sign before initiating an Internet transaction for the sale of that good. See the following court cases which justify the motivation for combination of Berlin with FSBO :

*In re Scheckler*, 168 USPQ 716 (CCPA 1971)

It is not necessary that a reference actually suggest changes or possible improvements which applicant made. In the instant application, as per *In re Scheckler*, 168 USPQ 716 (CCPA 1971) it is not necessary for the prior art reference to actually suggest

same order of steps as claimed, so long all the steps as claimed are disclosed in the prior art reference. Also this analysis has to be considered in view of the analysis presented in 2 (i) above.

*In re Shepard*, 138 USPQ 148 (CCPA 1963)

"In considering disclosure of reference patent, it is pertinent to point out not only specific teachings of patent but also the reasonable inferences which one skilled in the art would logically draw therefrom." In the instant application, as per *In re Shepard*, 138 USPQ 148 (CCPA 1963) it is pertinent to point out that the prior art reference of FSBO/Berlin not only teaches all the steps of claims 1 and 38 as claimed but also the reasonable inference which one skilled in art would logically draw from those steps disclosed in FSBO/Berlin, like after buying the physical signs from the website an user can always go back to the web site and post a new sales information or change the old information by putting a new information at the web site because that physical sign can be used more than once and for more than one products without having to buy it again and again. Also this analysis has to be considered in view of the analysis presented in 2 (i) above.

In view of the above, the rejection of independent claims 1 and 38 and their dependencies 2-5, 7-15, 22-23, 26-35, 37, and 39-40 as submitted in the earlier office action, paper # 14 is maintained.

This is a Final action.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.1. Claims 1-3, 7-8, 13-14, 22-23, 26, 28-29, 32-38, and 40 are rejected under 35 U.S.C. 103(a) as being obvious over FSBO in view of Berlin.

With regards to claims 1-3, 7-8, 13-14, 22-23, 26, 28-29, 32-38, and 40, FSBO teaches a method for marketing a good via a website having a website address and permitting a seller to post information about said good thereon under a unique identifier, said website further permitting a prospective purchaser to enter said unique identifier in order to view said posted information (see at least pages 1-10) consisting essentially of the following steps in the following order.

***Note: The limitation, “consisting essentially of the following steps in the following order” in the preamble will be interpreted as “comprising” for reasons given and analyzed above in 2 (i).***

- (a) providing a physical sign, said physical sign having a preprinted website address, a space for a unique identifier, and an indication that a good is for sale or rent (at least see pages 4 and 9, “Custom Yard Signs”, and page 11);
- (b) a seller of said good purchasing said physical sign (at least see pages 4-10)
- (c) said seller logging onto said website to post said information thereon, said unique identifier being provided to said seller or entered by said seller at said website in connection with said seller posting said information on said website (see at least pages 1, 2, 4, 6, 11. Note:

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On page 9, Ad# indicated in the Yard sign, and on page 11, Listing # correspond to the unique identifier of the product in the instant application.)),

    said seller conspicuously placing said sign physically on or adjacent said good for sale or rent, wherein said unique identifier corresponds specifically to said good on said website (at least see pages 4 and 9, "Custom Yard Signs", and page 11),

    FSBO also discloses that the website provides the unique identifier to the seller to print it in said space on the said sign (see at least pages 1, 2, 4, 6, 11. Note: On page 9, Ad# indicated in the Yard sign, and on page 11, Listing # correspond to the unique identifier of the product in the instant application. ), permitting the said purchaser to browse plurality of goods listed on said website by category and geographic location, and to view posted information therefore without reference to said unique identifier (see at least page 2. Note: the purchaser can look for many other houses-goods-in different states.), providing a container into which said seller can deposit a sheet of paper containing information about said good at (at least see pages 4 and 9, "Custom Yard Signs". Note: On page 9, "Brochures" denote the container for brochures.), promoting said website to the general consuming public (at least see, pages 2, 3, 11,12,13).

    With regards to claims 22, 23, 26, 28, 29, 32, 33, 34, and 35, FSBO teaches all limitations of these claims (at least see, pages 2-13).

    FSBO does not teach buying/selling physical signs in retail stores. FSBO discloses that physical signs are sold online. As per knowledge generally available there are many people who do not feel comfortable in buying goods on-line due to a number of reasons and they would like to buy directly from the retail stores. Berlin expressly teaches many people who do not feel comfortable in buying goods on-line due to a number of reasons and they would like to buy directly from the retail stores (see at least col.3, line 60-col.4, line 14). In view of the knowledge generally available and as clearly expressed in Berlin it would be obvious to a person of an

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ordinary skill in the art at the time of the invention to modify FSBO to include the feature of selling signs at retail stores so that those people who do not feel comfortable in making purchases online can buy the signs in retail stores. Note: The examiner would also like to bring to the applicant's attention that his arguments, " From claim 1, it is now clear.....by first purchasing the "for sale " sign .....After having purchased .....he wishes to sell " (see remarks, page 3, lines 19-22) are not consistent with the language of the claim 1. Claim 1 does not recite the limitation of "first purchasing the "for sale " sign before initiating an Internet transaction for the sale of that good.

3.2. Claims 4-5, and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over FSBO/Berlin and further in view of Chiquette (US Patent 5,920,634).

With regards to claims 4-5, and 30-31, FSBO/Berlin teaches a method for marketing good as disclosed and analyzed in claims 1 and 26 above. FSBO/Berlin does not disclose providing a description of said good and seller's personal contact information thereon. However, in the same field of advertising display standards and technologies, Chiquette teaches providing a description of said good and seller's personal contact information thereon the sign (col.1, lines 14-24, ".....*The free standing advertising displays in common use today consist simply.....a visual panel hanging.....phone number...minimal detail about the thing being advertised*" ). It would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify FSBO/Berlin to include providing a description of said good and seller's personal contact information thereon the sign. Doing so would make information available to consumers and give them some idea about the product being sold and also whom to contact for more information.

3.3. Claims 9 and 39 are rejected under 35 U.S.C. 103(a) as being obvious over FSBO/Berlin in view of Weiner.

With regards to claim 9, FSBO/Berlin further discloses providing instructions to said seller about how to post information about said good on said website under said unique identifier (see FSBO at least page 3, 4, 6.). FSBO/Berlin also discloses preprinted web site addresses (see FSBO at least pages, 9, 11, "SeeHomePhoto.com", "FSBOAdvertisingService.com"). FSBO/Berlin does not disclose preprinting instructions for said seller about how to post said information on the sign.

Weiner teaches that physical signs include pre-printed instructions to provide intended guidelines to do certain things (see at least col.1, lines 36-col.2, line 68, Figs. 1 through 10 B. Note: In Weiner the intended purpose of the pre-printed instructions is to provide desired warning information to traffic). In view of Weiner, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify FSBO/Berlin to incorporate the feature of pre-printing intended instructions on the physical signs as explicitly taught in Weiner to display the desired information to the traffic because it would also enable FSBO/Berlin to provide a set of guidelines or instructions to carry out an intended function for which the sign is being purchased. Further, FSBO/Berlin/Weiner does not disclose that the intended function of the pre-printed instructions is to instruct the seller as how to post said information on the Website. However, it has been held that a recitation with respect to the manner in which a claimed article/apparatus is intended to be employed does not differentiate the claimed article/apparatus from a prior art, in this case FSBO/Berlin/Weiner, satisfying the claimed structural limitations, see *Ex parte Xasham*, 2 USPQ2d 1647 (1987). In view of the findings of this court case, the examiner has not accorded patentable weight to the intended function of the sign to guide said seller about how to post said information on a website.

See also following court cases which justify combining Weiner with FSBO/Berlin. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971) "Any judgment on obviousness is in a sense



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may be bodily incorporated into the claim to produce claim subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art." , *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) "A prior art reference is analogous if the reference is in the field of applicant's endeavor or, if not, the reference is reasonably pertinent to the particular problem with which the inventor was concerned", *Lamont v. Berguer*, 7 USPQ2d 1580 (BdPatApp&Int 1988) Section 103 requires us to presume that the artisan has full knowledge of the prior art in his field of endeavor and the ability to select and utilize knowledge from analogous arts.

With regards to claim 39, its limitations being similar to that of claim 9, it is analyzed and rejected on the basis of same rationale.

3.4. Claims 10,11, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over FSBO and further in view of Klingman (US Patent 5,799,285).

With regards to claims 10,11,12, and 15, FSBO/Berlin teaches a method of marketing a good as disclosed and analyzed in claim 1, above. FSBO/Berlin does not disclose making payments in the event of sale/purchase to seller directly or to the provider of web site so that provider can forward the payment to the seller, or to the provider from seller as a fee, or from the seller as a fee in connection with said posting of information on web site. As per knowledge generally available such payments in the event of sale/purchase to seller directly or to the provider of web site so that provider can forward the payment to the seller, or to the provider from seller as a fee, or from the seller as a fee in connection with said posting of information on web site are a common practice as expressed in Klingman (see at least. Col.4, lines 43-48, col.8, lines 6-8, col.9, lines 48-54, col.13, lines 31-33, and col.16, lines 2-16). It would have

been obvious to a person of an ordinary skill in the art at the time of the invention to make payments in the event of sale/purchase to seller directly or to the provider of web site so that provider can forward the payment to the seller, or to the provider from seller as a fee, or from the seller as a fee in connection with said posting of information on web site as expressly demonstrated in Klingman.

3.5. Claim 27 is rejected under 35 U.S.C. 103(a) as being obvious over FSBO/Berlin in view of Mahoney et al. (US Patent 6,003,255), hereinafter, referred to as Mahoney.

With regards to claim 27, FSBO/Berlin teaches a method for marketing a good as disclosed and analyzed in claim 1, and 26 above. FSBO/Berlin discloses that the goods being sold are homes/apartments/real estate properties. Though the same method can be used for marketing other goods FSBO/Berlin does not disclose that. However, Mahoney expressly discloses that physical signs are used to sell many different products including automobiles (see at least col.1, lines 1-67). In view of Mahoney, and as per knowledge generally available it would be obvious for a person of an ordinary skill in the art at the time of the invention to use physical signs in FSBO/Berlin to sell goods like automobiles also because physical advertising signs help to sell products (see at least Mahoney, col.1, lines 4-6, “.. Advertising signs and/or displays are used in a number of different businesses and frequently serve as point of sale devices ”).

#### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) Press release, " Owners.com Unveils Powerful New Site for Home Sellers and Home Buyers"; January 21, 1999 extracted on Internet from the web site:

<http://web.archive.org/web/20000618013127/www.owners.com> on 12/5/2003 and copies of web pages, a total of 12 pages discloses providing physical yard signs to sellers of their products and to post information about products being sold on a web site.

(ii) Rogers et al.; " Online companies find niche in sales owners get help with selling homes themselves"; Richmond Times-Dispatch; Richmond, VA; Jul 9, 2000; extracted on Internet on 12/5/2003 from web site: <http://proquest.umi.com> discloses selling marketing kits including yard signs and to post information about products being sold on a web site.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

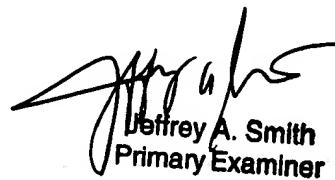
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg  
Examiner  
Art Unit 3625

YCG  
January 23, 2004



Jeffrey A. Smith  
Primary Examiner